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IN THE UNITED STATES PATENT AND  
TRADEMARK OFFICE

In re: Utility Application 10/604,961 Filed August 28, 2003  
Attorney Docket No.: 03-STE-01CIP  
Title of Invention: Integrated Plasma Fuel Cell Process  
Notice of Allowance: October 31, 2005  
Inventor: Meyer Steinberg  
Examiner: Mark Ruthkowsky  
Art Unit of Parent Application: 1745

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

Date of Reply: November 10, 2005

Sir:

## AMENDMENT AFTER NOTICE OF ALLOWANCE

Applicant herewith submits amendments to the claims after allowance pursuant to 37 CFR 1.312 and requests their entry.

The amendments reverse the examiner's amendments to the claims which deleted "for" after "steps" or "step" in claims 1 through 9.

Applicant intended to invoke 35 U.S.C. 112, sixth paragraph in using the "step for" claim structure. The examiner's amendment modified that "step for" plus function structure of the original claims and this amendment seeks to restore the applicability of 35 U.S.C. 112 in order to give the claims their broadest reasonable interpretation.

## Certificate of Transmission under 37 CFR 1.8

I hereby certify that this correspondence is being facsimile transmitted to the United States Patent and Trademark Office (671-273-8300) on November 10, 2005.



Louis Ventre, Jr.

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**EXPLANATION OF APPLICABILITY OF 37 CFR 1.312.** The detailed action statement accompanying the notice of allowability indicated that the examiner's amendment was made and that if the changes were unacceptable to applicant, then an amendment should be submitted before payment of the issuance fee as provided in 37 CFR 1.312.

37 CFR 1.312 provides, "No amendment may be made as a matter of right in an application after the mailing of the notice of allowance. Any amendment filed pursuant to this section must be filed before or with the payment of the issue fee, and may be entered on the recommendation of the primary examiner, approved by the Director, without withdrawing the application from issue."

The issuance fee has not been paid and the applicant seeks the recommendation of the primary examiner to enter the amendments to the claims without withdrawing the application from issue.

**APPLICABILITY OF 35 U.S.C. 112.** According to MPEP § 2181, "A claim limitation will be interpreted to invoke 35 U.S.C. 112, sixth paragraph, if it meets the following 3-prong analysis: (A) the claim limitations must use the phrase "means for" or "step for;" (B) the "means for" or "step for" must be modified by functional language; and (C) the phrase "means for" or "step for" must not be modified by sufficient structure, material or acts for achieving the specified function.

(A) Use of step for. The claims as submitted used the "step for" claims language and this prong of the analysis is met.

(B) Functional language. In each instance in all the claims, that is claims 1 through 9, the functional language "using" was included after the "step for". The act of using the element is what is accomplished. The underlying function of "using" each method claim element corresponds to what that element ultimately accomplishes as explicitly explained in the description. For example, in paragraph 26 of the description explains, "Thus, the step for using the Electric Arc Hydrogen Plasma Black Reactor involves use of the separated ash, sulfur, carbon, hydrogen and carbon monoxide

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1 effluents. Such use typically includes any commercial use such as selling any such  
2 effluent or discharging one or more of them as waste." Each such instance of using an  
3 element in all the claims is expressly defined in the description.

4 (C) Not modified by acts. The "step for" plus function, in each instance, is not  
5 modified by any acts for achieving the specified function.

6 Therefore all of the 3-prong analysis to determine applicability and invoke 35  
7 U.S.C. 112, sixth paragraph has been satisfied and the requested amendments should  
8 be entered.

9 **General Explanation on Claims Amendments.** The amendments to the claims  
10 made in response to the Detailed Action are presented in two separate documents in  
11 accordance with 37 CFR 121(c):

- 12 • The first presents all claims in clean version with the amended claims (claims 1  
13 and 8-11) indicated with a status of "currently amended".
- 14 • The second presents all claims with markings to indicate the changes that have  
15 been made relative to the immediate prior version of the claims. The text of the  
16 added subject matter (viz., the word "for") is shown by underlining the added text.

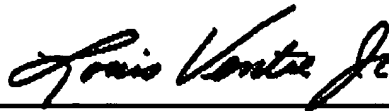
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1 CONCLUSIONS. No new claims are added and no claim is withdrawn. The  
2 amendments restore the claims to their original version before the examiner's  
3 amendment. No new matter is added by the amendments. The number of claims in the  
4 application remains the same. No change to the examiner's amendment to the abstract  
5 is sought. Therefore, applicant respectfully seeks entry of the requested amendments  
6 to the claims and allowance of the application so amended.

7 Attachments follow on pages 5 through 8.

Respectfully submitted,



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